



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/520,941

08/30/2005

Kimio Ishimaru

4752-003

4769

22429

7590

09/16/2010

LOWE HAUPTMAN HAM & BERNER, LLP
1700 DIAGONAL ROAD
SUITE 300
ALEXANDRIA, VA 22314

EXAMINER

SKINNER, SHEWANA D

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

09/16/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,941	Applicant(s) ISHIMARU ET AL.	
	Examiner SHEWANA SKINNER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is a First Action Non-Final on the merits. **Claims 1-20**, as originally filed, are currently pending and have been considered below.

Information Disclosure Statement

1. The information disclosure statements filed 1/12/2005 and 8/30/2005 fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. They have been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1, 4, 13 and 14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is unclear as to how a processing section that is defined within the specification as a CPU is able to provide a material such as a sample and strain. Therefore, the claims are indefinite.
3. **Claims 1, 13, and 14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. How does a processing section that is defined as a CPU obtain

Art Unit: 3689

a dividend Dt to a research-and-development intermediary organization and a dividend Dr to a research organization on the basis of consideration income obtained by technology transfer, which includes the information-disclosure charge LA” where "obtain" is defined by Webster's Dictionary as to gain or to attain. Examiner is unclear as to how a CPU gains or attains a dividend to an entity? The language of the claims, considered as a whole in light of the specification and given its broadest reasonable interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation and are therefore indefinite.

4. **Claims 1, 2, 13, and 14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims read a step to occur contingent on the term "when", where "when" statements are not interpreted as positively recited steps within a claim as they state of when may not occur. In addition, the claim does not recite what step occurs if the "when" does not occur. The language of the claims, considered as a whole in light of the specification and given its broadest reasonable interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation and are therefore indefinite.

5. **Claims 1, 2, 4, 5, 6, 8, 13, 14, 16,17, 18, 19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recited the phrase "research-theme identification information" where said phrase is not defined within the specification. The specification recites stored information including the research theme (disclosure pg 8 lines13-

Art Unit: 3689

14), however the specification does not disclose the meaning of research-theme identification information. Research theme information is the title of the database in Fig 5, however the Description of the Drawings recites Fig 5 as the technical seed database where technical seeds information is stored and it is Examiner's understanding that technical seed information is not the same as research-theme identification information. In addition, Examiner is unclear whether research theme information the same as research-theme identification information. The language of the claims, considered as a whole in light of the specification and given its broadest reasonable interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation and are therefore indefinite.

6. **Claim 4, 5 and 16** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recited the term "information-disclosure-charge income estimate" where said term is not defined within the specification nor is there any disclosure as to how estimate is derived. The language of the claims, considered as a whole in light of the specification and given its broadest reasonable interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation and are therefore indefinite.

7. **Claims 3, 5, 9 and 15** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recited the terms "research result", "profit index", "profit index rank", "information disclosure charge rate" and "risk coefficient" where said terms are not defined within the specification nor is there any disclosure as to how terms are derived is

Art Unit: 3689

derived. The language of the claims, considered as a whole in light of the specification and given its broadest reasonable interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation and are therefore indefinite.

8. **Claims 6, 8, 9, 17 and 18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recited the term “license fee income estimate” where said term is not defined within the specification nor is there any disclosure as to how estimate is derived. The language of the claims, considered as a whole in light of the specification and given its broadest reasonable interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation and are therefore indefinite.

9. **Claims 11 and 19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recited the phrase “research-theme information” where said phrase is not defined within the specification. The specification recites stored information including the research theme (disclosure pg 8 lines13-14), however the specification does not disclose the meaning of research-theme information. Research theme information is the title of the database in Fig 5, however the Description of the Drawings recites Fig 5 as the technical seed database where technical seeds information is stored and it is Examiner’s understanding that technical seed information is not the same as research-theme information. The language of the claims, considered as a whole in light of the specification and given its broadest

Art Unit: 3689

reasonable interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation and are therefore indefinite.

10. **Claim 11** recites the limitation "research-theme information". There is insufficient antecedent basis for this limitation in the claim.

11. **Claim 14** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The medium being used is undefined within the claims and specification and therefore, the claim is indefinite.

12. **Claim 18** recites the limitation "optional-contract". There is insufficient antecedent basis for this limitation in the claim.

13. **Claim 19** recites the limitation " research-theme information ". There is insufficient antecedent basis for this limitation in the claim.

14. **Claim 19** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the term "distribution rate" where said term is not defined within the specification nor is there any disclosure as to how term is derived. The language of the claims, considered as a whole in light of the specification and given its broadest reasonable interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation and are therefore indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Art Unit: 3689

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. **Claim 13** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The present claims are directed to merely a program executed on a computer. The program does not claim a medium and thus, the claim amounts to software program per se. A software program per se is considered nonfunctional descriptive material that does not fit into the four statutory classes of method, apparatus, an article of manufacture and composition of matter and is therefore non-statutory subject matter.

16. **Claim 14** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is drawn to a computer-readable medium having a program stored thereon, however the specification fails to define the medium, which creates the possibility that the medium is a signal where signals are non-statutory subject matter. Therefore a claim drawn to such an undefined computer readable medium that covers both transitory and non-transitory embodiments must be amended to narrow that claim to only statutory embodiments to overcome a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3689

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Frank et al (US 7,127,405)*, hereinafter “*Frank*”.

As per Claims 1-2, 13 and 14, *Frank* discloses a system, computer-readable medium with a program for performing the method (col 14 lines 57-60) of managing the life cycle of intellectual property (*col 4 lines 16-18 and col 14 lines 18-24 and 51-54*) where possible types of intellectual property are disclosed, selected and developed (*col 15 lines 15-31, col 15 lines 66-67 through col 16 lines 1-5, col 17 lines 22-34, col 6 lines 46-53, and col 5 lines 12-14*) and data about the property is collected and disclosed (*col 17 lines 31-34, col 4 lines 44-58 and col 5 lines 12-15*). Contracts between the company and the innovator (col 6 lines 38-40 ad col 17 lines 44-50) pertaining to the IP licensing and disclosure (col 10 lines 27-28, 45) are then created and stored via the server depending on the terms, conditions and intentions of the contracting parties (*col 5 lines 56-59, col 7 lines 45-67 through col 8 lines 1-5, col 12 lines 63-64, col 30 lines 60-67 through col 31 lines 1-4 and col 35 lines 24-67 where the contract database has fields that dictate what type of contract will be formed, col 60 lines 38-5 and col 103 lines 43-48*) where the cost of the contracts is determined and stored in the financial information data i.e. revenue cost, license fees and royalties (*col 9 lines 17-19, col 12 lines 62-63, col 57 lines 59-62, col 58 lines 31-35, col 60 lines 56-65*), displays said contract to the user (*col 62 lines 4-10*) and the innovators are compensated for the technology (col 8 lines 24-25,

Although *Frank* discloses the method and system of creating contracts based on the type of contract and dependent on the terms of the contract between parties where said terms include costs and revenues (*col 7 lines 45-67*), it does not explicitly state the type of cost being the cost

Art Unit: 3689

for information disclosure. However, examiner takes official notice that it is well known in contracts to set charges pertaining to the terms of the contract, which in this case would be the charge of disclosing the information of a potentially patentable invention and that charging for disclosing information is well-known when forming contracts for the right to use intellectual concepts (i.e. patents)

Therefore, as both the official notice statement and *Frank* disclose the concept of contract formation and the terms used, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of the official notice statement with the reference of *Frank*, as *Frank* teaches the creation of contracts when involving intellectual concepts (i.e. patents) using terms such as cost and the official notice statement teaches that the cost to disclose information is a common term featured in contracts for intellectual concepts (i.e. patents) where said combination would create a contract type that is well-known in the field of intellectual property disclosure and licensing.

As per Claim 3, *Frank* discloses the research-and-development technology transfer method according to Claim 1, wherein the technical-seeds information further comprises a profit index R, a profit-index rank, or a risk coefficient I (col 24 lines 57, col 31 lines 36-37, where the type of information is non-functional as the steps of the method would be performed the same regardless)

As per Claim 4, *Frank* discloses the research-and-development technology transfer method according to one-of Claim[[s]] 1, wherein the step in which the processing section executes the information-disclosure-contract processing comprises:

Art Unit: 3689

a step in which the processing section sets the information-disclosure charge LA by reading an information-disclosure-charge income estimate F corresponding to the research-theme identification information from the storage section and using the information-disclosure-charge income estimate F, or by reading the total research-and-development investment A from the storage section and using a predetermined equation (col 29 lines 37-67);

a step in which the processing section reads contract data which includes contract terms and conditions corresponding to the research-theme identification information from the storage section, and presents the contract data together with the information-disclosure charge LA to the company computer through a communication network (col 7 lines 58-67 through col 8 lines 1-6);

a step in which the processing section receives contract-consent data from the company computer (col 7 lines 66-67 through col 8 lines 1-10) ;

a step in which the processing section stores the research-theme identification information, the information-disclosure charge LA, a contract period, and the contract-consent data in the storage section corresponding to the company identification information (col 8 lines 1-10 and col 35 lines 30-40); and

a step in which the processing section reads the detailed information-disclosure information stored in the storage section correspondingly to the research-theme identification information, discloses the detailed information-disclosure information to the company computer, and/or provides a material, such as a sample or a strain (col 10 lines 27-28 and 45-46).

As per Claim 5, *Frank* discloses the research-and-development technology transfer method according to Claim 4, wherein the step in which the processing section executes the

Art Unit: 3689

information disclosure charge LA is one of a step in which the processing section calculates the information disclosure charge LA according to an information-disclosure-charge rate α set in advance and the total research-and-development investment A corresponding to the research-theme identification information, read from the storage section, by using the following equation

$$LA = \alpha \times A;$$

a step in which the processing section calculates the information-disclosure charge LA according to an information-disclosure-charge rate α set in advance, the total research-and-development investment A corresponding to the research-theme identification information, read from the storage section, the market value D of the research result, and a success probability E by using the following equation $LA = \alpha \times A \times D \times E$; and

a step in which the processing section calculates the information-disclosure charge LA by using the following equation according to an information-disclosure-charge rate α' set in advance, the total research-and-development investment A corresponding to the research-theme identification information, read from the storage section, and a profit index R read from the storage section or calculated according the market value D of the research result, the success probability E, and a risk coefficient I by using the following equation

$$R = D \times E/I$$

$LA = \alpha' \times A \times R$ (col 29 lines 37 -67 where calculations are used to derive the estimates charges, revenues).

Art Unit: 3689

As per Claim 6, *Frank* discloses the research-and-development technology transfer method according to Claim1, wherein the step in which the processing section executes the license agreement processing comprises:

a step in which the processing section sets the license fee LC by reading a license fee income estimate H corresponding to the research-theme identification information from the storage section and using the license fee income estimate H, or by reading the royalty data from the storage section and using a predetermined equation (col 9 lines 17-25 where license fees are determined by royalty data);

a step in which the processing section reads contract data which includes contract terms and conditions corresponding to the research-theme identification information from the storage section, and presents the contract data together with the license fee LC to the company computer (col 7 lines 58-67 through col 8 lines 1-6);

a step in which the processing section receives contract-consent data from the company computer (col 7 lines 58-67 through col 8 lines 1-10);

a step in which the processing section stores the research-theme identification information, the license fee LC, a contract period, and the contract-consent data in the storage section corresponding to the company identification information (col 7 lines 58-67 through col 8 lines 1-6 and col 35 lines 30-40); and

a step in which the processing section reports to the company computer that a license for the research-theme identification information has been given (col 7 lines 58-67 through col 8 lines 1-6, col 40 lines 2-5, col 79 line 43, col 86 lines 5-10 and 40-47).

Art Unit: 3689

As per Claim 7, (currently amended): The research-and-development technology transfer method according to Claim 6, wherein, in the step in which the processing section sets the license fee LC,

the processing section calculates the license fee LC according to a business sales estimate C, a royalty estimate r, and a lump-sum-payment estimate Ls read from the storage section by using an equation of $LC = C \times r + Ls$ (col 29 lines 37 -67 where calculations are used to derive the estimates charges, revenues).

As per Claim 8, *Frank* discloses the research-and-development technology transfer method according to Claim 2, wherein the step in which the processing section executes the optional-contract processing comprises:

a step in which the processing section sets the option charge LB by reading an optional-charge income estimate G corresponding to the research-theme identification information from the storage section and using the optional-charge income estimate G, or by using a predetermined equation with the use of the license fee income estimate H (col 60 lines where license fee is used to determine income estimate);

a step in which the processing section reads contract data which includes an optional-contract period and contract terms and conditions corresponding to the research-theme identification information from the storage section, and presents the contract data together with the option charge LB to the company computer; (col 7 lines 58-67 through col 8 lines 1-6)

a step in which the processing section receives contract-consent data from the company computer; (col 7 lines 58-67 through col 8 lines 1-10)

Art Unit: 3689

a step in which the processing section stores the research-theme identification information, the option charge LB, a contract period, an optional-contract period, and the contract-consent data in the storage section corresponding to the company identification information (col 7 lines 58-67 through col 8 lines 1-6 and col 35 lines 30-40); and

a step in which the processing section reports to the company computer that an option right for the research-theme identification information has been given(col 7 lines 58-67 through col 8 lines 1-6, col 40 lines 2-5, col 79 line 43, col 86 lines 5-10 and 40-47).

As per Claim 9, *Frank* discloses the research-and-development technology transfer method according to Claim 8, wherein the step in which the processing section sets the option charge LB is one of

a step in which the processing section calculates the option charge LB according to an optional-charge rate 13 set in advance and the license fee income estimate H by using the following equation

$$LB = \beta \times H;$$

a step in which the processing section calculates the option charge LB according to an optional-charge rate 13' set in advance, the license fee income estimate H, and the market value D of the research result and a success probability E both read from the storage section by using the following equation

$$LB = \beta \times H \times D \times E; \text{ and}$$

a step in which the processing section calculates the option charge LB by using the following equation according to an optional-charge rate [3" set in advance, the license fee

Art Unit: 3689

income estimate H, and a profit index R read from the storage section or a profit index R calculated according the market value D of the research result, the success probability E, and a risk coefficient I by using the following equation

$$R = D \times E/I$$

$LB = \beta \times H \times R$ (col 29 lines 37 -67 where calculations are used to derive the estimates charges, revenues).

As per Claim 10, *Frank* discloses the research-and-development technology transfer method according to Claim 8, wherein

the processing section reads the license fee income estimate H from the storage section, or calculates the license fee income estimate H according to a business sales estimate C, a royalty estimate r, and a lump-sum-payment estimate Ls read from the storage section by using an equation of $H = C \times r + Ls$ (col 29 lines 37 -67 where calculations are used to derive the estimates charges, revenues).

As per Claim 11, *Frank* discloses the research-and-development technology transfer method according to Claim 1 , wherein the step in which the processing section performs the distribution processing comprises:

a step in which the processing section reads the information-disclosure income LA, the optional-contract charge LB, the license fee LC, and a distribution rate Y for the research-and-development intermediary organization, corresponding to detailed research-theme information from the storage section;

Art Unit: 3689

a step in which the processing section obtains the whole consideration L for research and development according to the information-disclosure income LA, the optional-contract charge

LB, the license fee LC which are read, by the use of the following equation,

$$L = LA + LB + LC; \text{ and}$$

a step in which the processing section calculates a dividend Dt to the research-and-development intermediary organization and a dividend Dr to the research organization according to the obtained whole consideration L for research and development and the distribution rate Y for the research-and-development intermediary organization, read from the storage section, by the use of the following equation,

$$Dt = L \times Y$$

$Dr = L \times (1 - Y)$ (col 29 lines 37 -67 where calculations are used to derive the estimates charges, revenues).

As per Claim 15, *Frank* discloses the research-and-development technology transfer method according to Claim

2, wherein the technical-seeds information further comprises a profit index R, a profit-index rank, or a risk coefficient I. (col 24 lines 57, col 31 lines 36-37, where the type of information is non-functional as the steps of the method would be performed the same regardless)

As per Claim 16, *Frank* discloses the research-and-development technology transfer method according to Claim 2, wherein the step in which the processing section executes the information-disclosure-contract processing comprises:

Art Unit: 3689

a step in which the processing section sets the information-disclosure charge LA by reading an information-disclosure-charge income estimate F corresponding to the research-theme identification information from the storage section and using the information-disclosure-charge income estimate F, or by reading the total research-and-development investment A from the storage section and using a predetermined equation (col 29 lines 38-67 - tracks R&D costs and budgets and sets fees);

a step in which the processing section reads contract data which includes contract terms and conditions corresponding to the research-theme identification information from the storage section, and presents the contract data together with the information-disclosure charge LA to the company computer through a communication network (col 7 lines 58-67 through col 8 lines 1-6);

a step in which the processing section receives contract-consent data from the company computer (col 7 lines 58-67 through col 8 lines 1-10);

a step in which the processing section stores the research-theme identification information, the information-disclosure charge LA, a contract period, and the contract-consent data in the storage section corresponding to the company identification information (col 7 lines 58-67 through col 8 lines 1-6 and col 35 lines 30-40); and

a step in which the processing section reads the detailed information-disclosure information stored in the storage section correspondingly to the research-theme identification information, discloses the detailed information-disclosure information to the company computer (col 22 lines 33-47),

and/or provides a material, such as a sample or a strain.

Art Unit: 3689

As per Claim 17, *Frank* discloses the research-and-development technology transfer method according to Claim 2, wherein the step in which the processing section executes the license agreement processing comprises:

a step in which the processing section sets the license fee LC by reading a license fee income estimate H corresponding to the research-theme identification information from the storage section and using the license fee income estimate H, or by reading the royalty data from the storage section and using a predetermined equation (col9 lines 17-25 where the royalty is used to determine the license);

a step in which the processing section reads contract data which includes contract terms and conditions corresponding to the research-theme identification information from the storage section, and presents the contract data together with the license fee LC to the company computer (col 7 lines 58-67 through col 8 lines 1-6);

a step in which the processing section receives contract-consent data from the company computer (col 7 lines 58-67 through col 8 lines 1-10);

a step in which the processing section stores the research-theme identification information, the license fee LC, a contract period, and the contract-consent data in the storage section corresponding to the company identification information (col 7 lines 58-67 through col 8 lines 1-6 and col 35 lines 30-40); and

a step in which the processing section reports to the company computer that a license for the research-theme identification information has been given (col 7 lines 58-67 through col 8 lines 1-6, col 40 lines 2-5, col 79 line 43, col 86 lines 5-10 and 40-47).

Art Unit: 3689

As per Claim 18, *Frank* discloses the research-and-development technology transfer method according to Claim 3, wherein the step in which the processing section executes the optional-contract processing comprises:

a step in which the processing section sets the option charge LB by reading an optional-charge income estimate G corresponding to the research-theme identification information from the storage section and using the optional-charge income estimate G, or by using a predetermined equation with the use of the license fee income estimate H (col 29 lines 37-67 where the licensing revenues are used to determine the forecasted income);

a step in which the processing section reads contract data which includes an optional-contract period and contract terms and conditions corresponding to the research-theme identification information from the storage section, and presents the contract data together with the option charge LB to the company computer (col 7 lines 58-67 through col 8 lines 1-6);

a step in which the processing section receives contract-consent data from the company computer (col 7 lines 58-67 through col 8 lines 1-10);

a step in which the processing section stores the research-theme identification information, the option charge LB, a contract period, an optional-contract period, and the contract-consent data in the storage section corresponding to the company identification information (col 7 lines 58-67 through col 8 lines 1-6 and col 35 lines 30-40); and

a step in which the processing section reports to the company computer that an option right for the research-theme identification information has been given (col 7 lines 58-67 through col 8 lines 1-6, col 40 lines 2-5, col 79 line 43, col 86 lines 5-10 and 40-47).

Art Unit: 3689

As per Claim19, *Frank* discloses the research-and-development technology transfer method according to Claim 2, wherein the step in which the processing section performs the distribution processing comprises:

a step in which the processing section reads the information-disclosure income LA, the optional-contract charge LB, the license fee LC, and a distribution rate Y for the research-and-development intermediary organization, corresponding to detailed research-theme information from the storage section;

a step in which the processing section obtains the whole consideration L for research and development according to the information-disclosure income LA, the optional-contract charge

LB, the license fee LC which are read, by the use of the following equation,

$$L = LA + LB + LC; \text{ and}$$

a step in which the processing section calculates a dividend Dt to the research-and-development intermediary organization and a dividend Dr to the research organization according to the obtained whole consideration L for research and development and the distribution rate Y for the research-and-development intermediary organization, read from the storage section, by the use of the following equation,

$$Dt=L \times Y$$

$Dr =L \times (1 - Y)$ (col 29 lines 37 -67 where calculations are used to derive the estimates charges, revenues).

Art Unit: 3689

18. **Claims 12 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Frank et al* (US 7,127,405), hereinafter “*Frank*” in view of *Rivette et al* (US 2003/0046307), hereinafter “*Rivette*”.

As per **Claims 12 and 20**, *Frank* discloses the research-and-development technology transfer method according to Claims 1 and 2 where the system is accessed via a user and receives and stores company-related information (col 34 lines 11-30 and Figs 21 and 22).

However, although it could be reasoned that the type of information claimed is not functional to the method and therefore should not be provided weight in distinguishing the claim from the prior art, *Frank* does not explicitly disclose a password corresponding to the company identification information being stored in the database.

Rivette also discloses a research and development transfer method where the company analyzes its intellectual property portfolio and determines whether to obtain, license or sell patent [11 and 261], where a password is assigned to the user of the system and stored in correlation to the user's information [941, 965 and 1151].

Therefore, it would have been obvious to one of ordinary skill in that art at the time the invention was made for *Frank* to have a password for the user of the system as it is common to have passwords used for registering and it is also common for companies to utilize systems with passwords because securing the access to proprietary information is a top priority.

Conclusion

Art Unit: 3689

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Germeradd et al (US 2002/0035499)*, *Sick et al (US 2002/0040338)*, *Goodman et al (US 2004/0122841)*, *Prokoski (US 2002/0046038)* and *Vollenweider et al (US 2008/0091620)*..

Art Unit: 3689

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWANA SKINNER whose telephone number is (571)270-7141. The examiner can normally be reached on Monday-Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mooneyham Janice can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHEWANA SKINNER/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689